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09/992,131	11/15/2001	Fred J. Pinciario	31049-1001	4627

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EXAMINER

PAYNE, SHARON E

ART UNIT PAPER NUMBER

2875

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/992,131	Applicant(s) PINCIARO, FRED J.	
	Examiner Sharon E. Payne	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 31-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15,31-43 and 46-50 is/are rejected.
- 7) ☒ Claim(s) 8,44 and 45 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tapered holder, balls and beads (all from claim 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by DeMars (U.S. Patent 5,323,492).

Regarding claim 1, DeMars discloses at least one decorative accessory element (Fig. 3) comprising at least one holding element (Fig. 5) comprising an end for receipt of a disposable and replaceable chemiluminescent article (Fig. 3, bottom portion holding element that is between the ears where end of chemiluminescent article is supposed to be located) and a main body (Fig. 3), at least one chemiluminescent article disposable and replaceable by the wearer in the at least one holding element via the end (Fig. 3) and the main body comprising at least one

opening in addition to the end for directly display the chemiluminescent article (Fig. 3, outer portion of the ear).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-14, 31-32, 36, 38-43, 46, 47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld (U.S. Patent 4,061,910) in view of Tedham et al. (U.S. Patent 6,431,724).

Regarding claim 1, Rosenfeld discloses at least one decorative accessory (Fig. 6) comprising at least one holding element comprising an end (Fig. 6) for receipt of a disposable and replaceable chemiluminescent article (reference numbers 73, 74 and 75) and a main body (Fig. 6) the main body comprising at least one opening (Fig. 6, opposite of reference number 74 filled with chemiluminescent article) for directly displaying the chemiluminescent article (reference number 78), and at least one chemiluminescent article (reference number 78) disposable and replaceable by the wearer in the at least one holding element via the end (column 10 in lines 9-11, Fig. 6). Rosenfeld does not disclose the opening in addition to the end.

Tedham et al. discloses at least one opening in addition to the end. (See Fig. 4; the chemiluminescent article is directly visible on both ends.) The chemiluminescent article is still

being directly displayed at two points because a user looking inside the bag can see the article directly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the additional opening of Tedham et al. in the apparatus of Rosenfeld to display directly the chemiluminescent article.

Regarding claim 2, Rosenfeld discloses the decorative accessory element comprising a reflective element (column 9, lines 34-38).

Concerning claim 3, Rosenfeld discloses the reflective element comprising metal (column 9, line 33). (The reference states that any material may be used, but rings are normally made of metal.)

Regarding claim 4, Rosenfeld discloses a reflective element comprising a finished surface (column 9, line 35).

Concerning claim 5, Rosenfeld discloses a reflective element that comprises a shape (Fig. 7).

Regarding claim 6, Rosenfeld discloses a reflective element that has a three-dimensional shape (Fig. 7).

Concerning claim 7, Rosenfeld discloses the holding element comprising a closing member (reference number 62).

Regarding claim 9, Rosenfeld discloses multiple holding elements (Fig. 6, reference numbers 73, 74 and 75).

Regarding claim 10, Rosenfeld discloses a holding element comprising a partially opaque member (side walls 64 are opaque).

Concerning claim 11, Rosenfeld discloses the partially opaque member having a fixed translucent area (wall surface 62 is translucent).

Regarding claim 12, Rosenfeld discloses a decorative element additionally comprising an ornamental element wherein the ornamental element comprises a translucent member (semi-precious stone, column 9 in line 34).

Concerning claim 13, Rosenfeld discloses the ornamental element as being a semi-precious stone (column 9, line 34).

Regarding claim 14, Rosenfeld discloses the ornamental element being back-lit by the chemiluminescent article (column 9, lines 1-30).

Regarding claim 31, Rosenfeld does not disclose a purse or satchel. Tedham et al. discloses a satchel (Fig.1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the satchel of Tedham et al. with the apparatus of Rosenfeld for carrying articles in a lighted bag.

Concerning claim 32, Rosenfeld and Tedham et al. do not specifically disclose multiple openings. Multiple openings are considered to be an obvious variation in design. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make multiple openings, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 36, Rosenfeld discloses a polished surface (column 9, line 35).

Concerning claims 38-40, 42-43, Rosenfeld does not specifically disclose the shapes of the reflective element. Forming the reflective element into a particular shape is considered to be an obvious variation in design, because it is well known that reflective elements can be cut into any shape. Since cutting or shaping the reflective element as desired is well known in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the reflective element into the specific shapes listed in these claims.

Regarding claim 41, Rosenfeld discloses a reflective element that is rectangular (Fig. 7).

Concerning claim 46, Rosenfeld discloses a cover (reference number 62).

Regarding claim 47, Rosenfeld discloses a necklace (Fig. 1).

Concerning claim 50, Rosenfeld discloses a ring (Fig. 7).

6. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld in view of Tedham et al. as applied to claim 1 above, and further in view of Ledingham (U.S. Patent 3,624,384).

Regarding claim 15, Rosenfeld does not disclose an earring. Ledingham discloses an earring (Fig. 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the earring of Ledingham in as part of the apparatus of Rosenfeld to enable a person to wear the apparatus on the ear.

7. Claim 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld in view of Tedham et al. as applied to claim 4 above, and further in view of Brams.

Regarding claim 33, Rosenfeld does not disclose a hammered surface. Brams discloses a hammered surface (column 6, line 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the hammered surface of Brams in the apparatus of Rosenfeld to improve the appearance of the article.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld in view of Tedham et al. as applied to claim 4 above, and further in view of Mizoguchi (U.S. Patent 6,102,555).

Regarding claim 34, Rosenfeld does not disclose a ribbed surface. Mizoguchi discloses a ribbed surface (Fig. 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the ribs of Mizoguchi in the apparatus of Rosenfeld to improve the appearance of the apparatus.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld in view of Tedham et al. as applied to claim 4 above, and further in view of Feuer (U.S. Patent 6,691,533).

Regarding claim 35, Rosenfeld does not disclose a paneled surface. Feuer discloses a paneled surface (Fig. 1).

It would have been obvious to one of ordinary skill in the art to use the paneled surface of Feuer in the apparatus of Rosenfeld to enhance the appearance of the article.

10. Claim 37 rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenfeld in view of Tedham et al. as applied to claim 37 above, and further in view of Huang (U.S. Patent 4,280,171).

Regarding claim 37, Rosenfeld does not disclose a slightly reflective surface. Huang discloses a slightly reflective surface (column 2, lines 20-26).



It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the slightly reflective surface of Huang in the apparatus of Rosenfeld to partially reflect light.

11. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMars in view of Tseng (U.S. Publication 2001/0017041 A1).

DeMars does not disclose a pendant. Tseng discloses a pendant (Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pendant of Tseng as part of the apparatus of DeMars to enable a person to wear the apparatus as a necklace. See also column 2, lines 50-55 in DeMars for the suggestion to combine the references.

12. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMars in view of Michael (U.S. Patent 6,659,617 B1).

Regarding claim 49, DeMars does not specifically disclose a brooch. Michael discloses a brooch (column 2, lines 50-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the brooch of Michael as part of the apparatus of DeMars to enable one to pin the apparatus on some clothing. See also column 2, lines 50-55 in DeMars for the suggestion to combine the references.

***Allowable Subject Matter***

13. Claims 8, 44 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter. The prior art fails to disclose a lighted accessory with a tapered holder as recited in claim 8.

Regarding claims 44 and 45, Rosenfeld and Tedham et al. disclose the elements of claim 7 for the reasons discussed in the rejection. The ball of claim 44 is disclosed in Bryan (U.S. Patent 6,340,235), but no motivation exists to combine Bryan with Rosenfeld. The bead of claim 45 is disclosed in Dorsen et al. (U.S. Patent 4,294,299), but no motivation exists to combine Dorsen with Rosenfeld.

#### ***Response to Arguments***

15. Applicant's arguments filed 2 January 2004 have been fully considered but they are not persuasive.

Applicant argues that Rosenfeld does not have a reflective surface. To the contrary, the outside of the ring in Rosenfeld has reflective material. (The outside of the ring reflects ambient light; furthermore, the transmissive material of Rosenfeld reflects some light as well.) Thus, the rejection of claim 2 stands.

Applicant argues that Rosenfeld does not disclose any of the finished surfaces in the claims presented by Applicant. To the contrary, Rosenfeld discloses a polished surface. See column 9, lines 34-38. Thus, the rejection of claim 4 stands.

Applicant argues that the shapes of the reflective elements disclosed in the claims are distinct from Rosenfeld. To the contrary, Rosenfeld discloses a reflective element for the

reasons stated above. The shapes are obvious variations and do not describe patentable differences. It is well known to cut or shape reflective material, such as metal in jewelry, into any shape desired.

Applicant argues that Rosenfeld does not disclose a closing member. To the contrary, reference number 62 shields the inside of the ring from the outside elements. Even though it is made of light-transmissible material, it is still a closing member, because it closes off the top of the ring. Thus, the rejections of claims 7 and 8 stand.

Applicant argues that Rosenfeld does not disclose an earring, pendant or brooch. Other references have been found that disclose these items. Thus claims 15, 47 and 48 are not allowable.

Applicant argues that Rosenfeld and Tedham et al. cannot be combined, because neither reference discloses direct display of the stick other than at one end opening. For the reasons disclosed in the rejection of claim 1, Tedham et al. discloses the direct display of the stick at a position other than the first end (the second end). A user can see this display on the inside of the bag, which means that the chemiluminescent stick is directly displayed. Thus, Tedham et al meet this element of claim 1.

Applicant further argues that one of ordinary skill in the art would not have combined Rosenfeld and Tedham et al., because Rosenfeld discloses complex light stick jewelry and Tedham et al. discloses a chemiluminescent article in the hem of a bag. To the contrary, the necklace of Rosenfeld is relatively simple, and both references deal with chemiluminescent articles that are worn by a user. (A purse or a bag is worn on the shoulder of a user.) Thus, the two references can be combined.

Applicant argues that claims 3, 9-14, 47 and 50 are allowable because they depend on claim 1. To the contrary, claim 1 is not allowable, and these claims fall with claim 1.


**Conclusion**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon E. Payne whose telephone number is (571) 272-2379. The examiner can normally be reached on regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sep

  
Stephen Husar  
Primary Examiner